

IN THE
United States Circuit Court of Appeals
For the Ninth Circuit

CLAYTON T. EAID and JOSEPH A. McCONNELL
APPELLANTS

VS.

TWOHY BROS. COMPANY, a Corporation
JOHN TWOHY,
THE NORTHWESTERN EQUIPMENT COMPANY
a Corporation, and
ELBERT G. CHANDLER
APPELLEES

Petition for Rehearing

JOSEPH L. ATKINS,
RICHARD SLEIGHT,
Attorneys for Petitioners
GLENN E. HUSTED,
Of Counsel

Filed

MAR 6 - 1911

F. D. McCONNELL

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

CLAYTON T. EAID, and JOSEPH A.
McCONNELL,
Appellants,

vs.

TWOHY BROS. COMPANY, a Corporation, JOHN
TWOHY, THE NORTHWESTERN EQUIP-
MENT COMPANY, a Corporation, and EL-
BERT G. CHANDLER,
Appellees.

Petition for Rehearing

*To the Honorable, the United States Circuit Court
of Appeals for the Ninth Circuit.*

Appellants petition for rehearing and humbly
show:

This Honorable Court, in affirming the court
below, in some manner came to consider exhibits ex-
cluded by the trial court, and it seems the decision
is founded on those very papers. (See Decision,
pages 2, 3, 4, 5.)

The fact that these exhibits were considered at
all entitles your petitioners to a rehearing.

The said exhibits are Defendants' Exhibit 10, alleged patent to Manly Wilbur, and Defendants' Exhibit 11, alleged patent to Robert Thompson.

Their admission was objected to upon the ground that they were not certified. See U. S. R. S., Title XIII, Sec. 892.

The trial court sustained the objection.

See Record, page 71, next to last paragraph.

Counsel for appellees assumed (Appellees' Brief, page 9) these exhibits were received in evidence, and this Honorable Court, probably misled thereby, overlooked the reference to their exclusion in Appellants' Brief (bottom of page 25 and top of page 26).

It will clarify the situation to explain that these particular exhibits were offered without notice and without any accompanying testimony at the very close of the trial (see Record, page 71). If they had been admitted the appellants should have produced to the Court evidence showing wherein they fail to anticipate the very gist of the McConnell invention, although to do so would have necessitated the reopening of the whole case; but when they were excluded that evidence could not be presented or considered.

Neither the trial court nor this Court would have permitted appellants to contest a position assumed by appellees, when the only evidence to support that position had been excluded by the Court.

This Honorable Court says (Decision, page 2)

“McConnell was compelled by the Patent Office to amend his claims in several respects in order to avoid anticipation and to secure a patent at all.”

This is a mistake. The Patent Office allowed the ten claims of the McConnell patent without any amendment except of claims 1, 2, and 4.

These particular claims were rejected upon the patent to Matheny, No. 513124. The same amendment, substantially, having been made in each of them, it will suffice to consider only claim 1.

The language of claim 1 before it was amended is the language of claim 1 of the patent except that in the patent the words “fixed” (line 5), and “only” (line 6), were introduced by the amendment, and the word “sliding” (line 7) was, by amendment, substituted for “swinging.”

The Patent Office thus decided that Matheny did not have “fixed means” and awarded claims thereto to McConnell.

In the case at bar the fixed means the Patent Office awarded to McConnell, are the very means which Chandler uses, and upon the use of which the infringement is, in part, predicated.

The foregoing analysis shows how, in respect to claims 1, 2, and 4, only, McConnell avoided the Matheny patent, and shows the mistake of the Court in stating that it was necessary for him to amend his claims “in order to secure a patent at all.”

Claim 10 demands special consideration. It defines the invention from an angle entirely differ-

ent from that of any other claim. It is not limited like claim 1 to "fixed" stop devices. Nowhere in the whole prior art is found the last element of the claim: "means for lowering the chock *to disengage it from said* (stop) *devices* and for sliding the chock while in lowered position." That is, any means for sliding a pivoted chock while in lowered position. Both the pivotal and the sliding movements are essential to the operation of the McConnell and of the Chandler devices. Chandler, as this Honorable Court observes (Decision, page 10), may move his chock "forward or back whether in an elevated position or not"; but that is purely incidental. The fact is in doing this and nothing more he does not accomplish the end he aims at. That end *demand*s the sliding of the chock in the lowered position under a log and then bringing it to an elevated position against the log. Sliding of the chock without lowering it will never insure the performance of its office. In other words, without the capacity for both sliding and pivotal movement it must often prove to be no chock at all.

In the development of the art prior to McConnell, chocks were made only to slide against the extreme outer circumference of a log. If they held there well and good. If not the chock action was lost. *McConnell conceived the new idea of sliding the chock in lowered position under the log, within the extreme outer circumference of the log and* BEYOND A POINT TO WHICH IT COULD BE SLID WITHOUT LOWERING IT, *and then raising it into the log.* It is

this very idea that Chandler has taken from McConnell.

Eaid describes this operation (Record, pp. 38-39) as follows: "The function performed by it (the chock) is the lowering of this chock, and *the log coming over the top of it,*" etc.

The pivotal and sliding operations are effected in both the McConnell and the Chandler devices by direct manipulation of the chock. McConnell was the first to make such manipulation possible. Chandler infringes by using the same means to the same end.

Claim 10 is broader than any other claim at any time presented in the case and was allowed by the Patent Office without criticism and without amendment.

Inspection of the Exhibit File Wrapper and Contents (McConnell Patent) will show that when in the prosecution of his application, McConnell found his claims as originally presented required amendment, he at the same time found them inadequate to define his real invention, and thereupon, with evident care and discriminating analysis of the art, he drew and presented claim 10.

It is the very office of a claim to give notice to the world of its intended scope. In claim 10, its language is stripped of limitations of other claims. It defines McConnell's invention in that broad language which the Patent Office concedes only to breadth of invention. The form of claim 10 is in marked contrast with all which preceded it.

Its form is that which the Commissioner of Patents holds to belong only to broad claims. *Ex parte Halfpenny*, 73 O. G., p. 1135.

In the opinion of this Honorable Court in addition to the excluded Exhibits 19 and 11, two patents which are in evidence are mentioned, namely, the patent to Matheny aforesaid and that to Parsons, but it should be remembered, in considering these, that the Patent Office allowed the McConnell patent in suit notwithstanding that both the Matheny and Parsons patents were considered in the adjudication of the McConnell application, and that neither they nor any reference was cited against claim 10.

A patentee despite amendment of a claim upon rejection is entitled by virtue of the amended claim allowed "to maintain and secure every improvement that he has invented that was not disclosed by the references on which his original claim was rejected." *Wayne Mfg. Co. vs. Benbow-Brammer*, 168 F. 271 (C. C. A.).

The McConnell patent in suit discloses not a mere advance in the art along lines already marked out, but a new principle, and one entitled to a liberal application of the doctrine of equivalents. This is the fact. Counsel believes the Court has failed to recognize that principle because counsel has not been fortunate enough to clearly and convincingly state the case for which they contend and the reasons upon which it is founded.

The rule of equivalents is well established. The

main difficulty is in its application to this case. Appellants never intended to urge that the McConnell invention is a pioneer in the broadest sense of that term, but only that it is a pioneer in a sense clearly recognized in many cases. In *Bundy Mfg. Co. vs. Detroit Time Register Co.*, 94 Fed. Rep. 524, a case similar to the present, the Court held Bundy, the inventor of a subordinate device, was a pioneer, though not in a broad sense, and "entitled to protect his real invention by a reasonable application of the rule of equivalents."

Counsel insists it is certain the excluded Exhibits should not have constituted an element in the decision of the Court—in fact should not have been considered at all. If these be omitted and only such interpretation and effect given to the Matheny and Parsons patents as the facts and law permit, there remains no sufficient ground to support and sustain the decision.

If this Honorable Court, as may be inferred from its comparison between the McConnell and the Chandler patents (Decision, pages 9 and 10), entertains the opinion that a difference between the mode of operation of the McConnell device and that of Chandler exists, the Court is urged to consider the testimony of the witness Blake on that very point, bearing in mind Blake is the only witness in the case acquainted with the contents of the McConnell and Chandler patents and who had seen the Twohy or Chandler Bunk "in actual operation in the woods" (Record, page 50, last paragraph). Appel-

lee Chandler may perhaps be assumed to know his own patent, but he does not testify to any knowledge of the McConnell patent. (Record, pp. 62-64.) The testimony of appellees' expert, Streng, is entitled to little consideration in view of his admission that he has no practical knowledge of the machines of either party in suit (Record, p. 69, see top and bottom). He himself is favorably impressed, upon hearing the evidence at the trial, by McConnell's device (Record, pp. 68-69).

Blake says: "The chock of the McConnell patent may be actuated by direct manipulation, just as the chock 9 of the Chandler patent may be operated, certainly. That is adjusted back and forth and thrown up." (Record, near bottom page 60.)

"I do not wish to be understood as stating that the McConnell chock is operated by any different means—is necessarily operated by any means different from those employed in the Chandler. *The two chocks are operated by exactly the same means.*" (Record, paragraph middle page 61.)

Counsel for petitioners, hereby certify that in their judgment this petition is well founded and is not interposed for delay. Counsel desire to add that in their opinion a rehearing in this case should be granted in order to meet the strict ends of justice.

And your petitioners will ever pray.

CLAYTON T. EAID and
JOSEPH A. McCONNELL,
Petitioners.

By JOSEPH L. ATKINS,
RICHARD SLEIGHT,
Their Attorneys.

GLENN E. HUSTED,
Of Counsel.

